

REMARKS

Claims 1-62 are pending in this application. Applicant has amended claims 1-46 to more particularly point out and distinctly claim applicant's invention. Applicant has also added new claims 47-62. No new matter has been added by way of these amendments.

Objection to Specification

The Examiner has objected to the placement of the title of the application. Although the title is the first line in the application, it may appear to the Examiner that the Express Mail information, which was part of the page header, is incorrectly placed. Thus, by amendment above, applicant has removed the Express Mail number (and its box), and the title of the application, "Brand-Name Recognition" is now apparent as the first line at the top of the specification on the first page; thus, rendering the objection moot. Applicant respectfully requests withdrawal of the objection to the specification.

Objection to the Claims

The Examiner has objected to the claims commenting that "it appears that the Applicant in many instances, within the claimed invention, uses the terms **vendor** and **retailer** interchangeably. It is important that the definition of terms remain consistent ..." [Office Action, dated 3/11/03, page 2 (hereinafter "Office Action")]. The Examiner further comments that he considers a "**vendor to be a coupon issuer 14 or distributor 16 and a retailer to be the owner of a retail store where coupons can be redeemed.**" [Office Action, page 2.]

Applicant respectfully disagrees and submits that the applicant has not used the terms inconsistently in the claims or in the specification of this application. It appears that the Examiner takes his definition of vendor and retailer from a reference (Barnett) that is used to reject the claims. This is not the definition that applicant's specification explicitly uses to define the term "vendor." Rather, according to applicant's specification and claims, a vendor can be a retailer, amongst other entities. A retailer can also be the owner of a retail store where coupons or in-store discounts may be redeemed. [See, e.g., Specification, page 13, lines 16-20, 25-28 (retailers that sell their own goods are purveyors of goods, hence vendors); page 14, lines 4-7; page 16, lines 24-25; page 2, lines 13-29; and Figure 3.]

Moreover, this objection to the claims appears to be irrelevant and moot, as applicant's claims, before and after amendment, *do not recite the term "vendor" at all*. Accordingly, applicant respectfully requests withdrawal of this objection to the claims.

35 U.S.C. § 101 Rejection

The Examiner has rejected under 35 U.S.C. § 101 claims 1-17 and 37-41 as directed to non-statutory subject matter in that they pertain to a manual process. Applicant has amended independent claims 1, 15, and 37 to recite the language "A method in a computer system ... comprising:" to make clear that the acts of the methods of claims 1-17 and 37-41 are performed by a computer implementation of the processes described. As described in the specification in Figure 1 and elsewhere, the methods recited in claims 1-17, 37-41, and in new claims 47-51 are performed by one or more computer systems. Applicant thus respectfully requests the Examiner to withdraw this rejection.

35 U.S.C. § 102 Rejection

The Examiner has rejected claims 1-46 under 35 U.S.C. § 102(e) as being anticipated by Barnett et al. ("Barnett"), U.S. Patent No. 6,321,208, issued November 20, 2001, and with a filing date of April 19, 1995. Applicant respectfully traverses this rejection for the reasons discussed in detail below with respect to both the original and amended claims.

In summary, Barnett is directed to a different aspect of electronic coupon distribution – that of targeting coupon packages for specific types of coupon users based upon consumer research data. [Barnett, 12:26-33, 37-41, 51-56, Figure 1, and Figure 10.] In contrast, applicant's claims are directed generally to computer systems and computer-implemented methods for assessing brand recognition of marks, such as trade marks and/or service marks, by tracking the selection of marks used to activate particular commands such as printing a shopping list. Barnett is not at all directed to, nor does Barnett describe, *any mechanism for tracking marks, let alone a mechanism for tracking brand-related marks used to activate commands*.

Specifically, each of applicant's independent claims (and by virtue of their incorporation, the dependent claims), before and after amendment, recite language that is directed in general to consumer awareness of marks used to activate a command. *The Examiner*

*has not indicated anywhere in the Office Action that Barnett or any other reference teaches, motivates, or suggests any of the recited claim language of the pending claims 1-46 (nor the similar language of new claims 47-62). Rather, it appears to applicant's representative that the Examiner may have copied his rejections from other office actions issued to related cases of applicant and has not addressed any recitation of language in applicant's pending claims at all. Specifically, he has not pointed to anywhere in the reference that teaches, suggests, or motivates applicant's claim recitations. Thus, the Examiner has not met his *prima facie* burden of establishing anticipation or obviousness of any of applicant's claims 1-62. [In re Rijkaert, 9 F3d 1531, 1532 (Fed Cir 1993) ("[i]n rejecting claims... the **examiner** bears the initial burden of presenting a *prima facie* case of obviousness ... only if that burden is met, **does** the burden of coming forward with evidence or argument shift to the applicant ... if the **examiner** fails ... the rejection is improper and will be overturned.").] Moreover, even assuming, *arguendo*, that such a burden had been met, which it has not, neither Barnett nor any reference cited by the Examiner refer in any way to such capabilities. Therefore, Barnett cannot possibly teach, suggest, or motivate applicant's claims. Applicant thus respectfully requests allowance of pending claims 1-62.*

In particular, independent claims 1 and 18 (hence dependent claims 2-14 and 19-31) before amendment recite,

1. A method ... comprising:
transmitting data to cause *display of at least two marks as activation mechanisms* for a ... command; and
determining relative consumer awareness of the at least two marks...

or similar language. In addition, after amendment, independent claims 1 and 18 (hence dependent claims 2-14 and 19-31) recite,

1. (Currently amended) A method ... comprising:
transmitting data to cause *display of at least two brand-related marks as activation mechanisms* to print ...; and
determining relative consumer awareness of the at least two marks...

or similar language. Thus, claims 1-14 and 18-31, before and after amendment, recite language directed to consumer awareness of marks used to activate a command.

Similarly, independent claims 15 and 32 (hence dependent claims 16-17 and 33-34) before amendment recite,

15. A method ... for *determining relative consumer awareness of at least two marks*, ...comprising:
accepting input *specifying at least two marks*; and
recalling *an accounting of past activations of the at least two marks* to
determine frequency of selection...

or similar language. In addition, after amendment, independent claims 15 and 32 (hence dependent claims 16-17 and 33-34) recite,

15. (Currently amended) A method ...for *determining relative consumer awareness of at least two brand-related marks*, comprising:
receiving an *indication of at least two brand-related marks*...;
retrieving an *accounting of past activations of the at least two marks* to
determine frequency of selection...

or similar language. Thus, claims 15 and 32, before and after amendment, recite language directed to relative consumer awareness of marks.

Similarly, independent claims 37 and 42 (hence dependent claims 38-41 and 43-46) before amendment recite,

37. A method ...comprising:
displaying at least *two marks as activation mechanisms for a ... command*;
and
transmitting data indicating *which of the at least two marks has been activated*.

or similar language. In addition, after amendment, independent claims 37 and 42 (hence dependent claims 38-41 and 43-46) recite,

37. (Currently amended) A method ... comprising:
displaying at least *two brand-related marks as activation mechanisms* to
print...; ...and
transmitting data that *indicates the selected mark*...

or similar language. Thus, independent claims 37 and 42 (and hence dependent claims 38-41 and 43-46), before and after amendment, recite language directed to consumer awareness of marks used to activate a command.

In addition, similar aspects of applicant's new claims are also not taught, suggested, or motivated by Barnett or by any other cited reference. Specifically, claims 60-62

are computer-readable memory medium versions of independent claims 1, 15, and 37 and are thus distinguishable for the same reasons discussed above with reference to claims 1, 15, and 37.

Also, newly added independent claims 47, 52, and 57 are method, system, and computer-readable memory medium claims, respectively, directed to measuring brand recognition by "display of a plurality of brand-specific marks, which, when selected, initiate an application-specific command; and ... measure brand recognition..." or similar language. These aspects are nowhere taught, suggested, or motivated by Barnett or by any other cited reference. Claims 47-51, 52-56, and 57-59 depend from claims 47, 52, and 57, respectively, and therefore recite similar language and are thus distinguishable for the same reasons as claims 47, 52, and 57.

For the reasons discussed above, and others, claims 1-62 are distinguishable from Barnett and are thus allowable. None of the recited aspects of claims 1-62 are addressed in Barnett or in any other cited reference. Moreover, Barnett doesn't even mention brands or marks at all. Therefore, because one or more aspects (acts or elements) of applicant's claims 1-46 (before or after amendment) and new claims 47-62 are not taught, suggested, or motivated by Barnett, Barnett cannot possibly anticipate or render obvious any of applicant's claims 1-62. Therefore, applicant respectfully submits that all of the remaining claims are allowable.

In closing, applicant respectfully requests the Examiner to reconsider this application and its early allowance. The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. The Examiner is invited to contact applicant's representative at (206) 622-4900 should the Examiner have any further questions.

Respectfully submitted,

Connie D. Myers

SEED Intellectual Property Law Group PLLC



Ellen M. Bierman
Registration No. 38,079

EMB:asl

Enclosure:

Postcard

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031
412155_3.DOC